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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,955	05/30/2001	Klaus-Dieter Hilliges	US20003638	9122

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EXAMINER

TORRES, JOSEPH D

ART UNIT PAPER NUMBER

2133

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,955

Applicant(s)

HILLIGES, KLAUS-DIETER

Examiner

Joseph D. Torres

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-15 is/are rejected.
- 7) ☒ Claim(s) 1,2 and 4-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. In view of the Amendment B of Paper No. 7 filed 08 December 2003, the Examiner withdraws all objections to the drawings.

Claim Objections

2. In view of the Amendment B of Paper No. 7 filed 08 December 2003, the Examiner withdraws the previous objection to claim 15 in the Office Action of Paper No. 6 filed 28 August 2003.

Response to Arguments

3. Applicant's arguments with respect to amended claims 1, 4, 5, 7, 10, 12, 13 and 15 and previously examined claims 2, 6, 8, 9 and 14 filed 08 December 2003 have been fully considered but they are not persuasive.

The Applicant contends, "the Cheung et al. patent neither expressly describes nor suggests, specifying a per-pin timing ... for each ATE-pin of the ATE-port, as recited in claim 1".

MPEP § 2131.01(III) states an Extra Reference or Evidence Can Be Used To Show an Inherent Characteristic of the Thing Taught by the Primary Reference: "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such

gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

The Examiner introduces the Derwent publication (Cheung et al., "Tester for multiple integrated circuit - produces sequence of test signals and has programmable memory for storing independent sequence", Copyright 1999 Derwent Information Ltd, Derwent-Week: 200246) as a teaching reference for that which is inherent in the Cheung patent, US 5461310 A. The Derwent publication is the European Patent Application version (Publication No. 0 474 275 A2) to the Cheung patent, US 5461310 A, hence is substantially the same patent for the European patenting office as the Cheung patent, US 5461310 A.

The Examiner asserts that the Abstract in the Derwent publication version of the Cheung patent, US 5461310 A, teaches that the timing control for each ATE pin is specified for independent groupings of said pin slice circuits. Note: the pin channels for a grouping comprise an ATE-port for the particular functional unit that is being tested; hence the pin slice circuits specify a per-pin timing ... for each ATE-pin of the independent groupings that make up an ATE-port.

The Examiner disagrees with the applicant and maintains all rejections of amended claims 1, 4, 5, 7, 10, 12, 13 and 15 and previously examined claims 2, 6, 8, 9 and 14.

All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that amended claims 1, 4, 5, 7, 10, 12, 13 and 15 and previously examined claims 2, 6, 8, 9 and 14 are not patentably distinct or non-obvious over the prior art of record in view of the reference, Cheung, David K. et al. (US 5461310 A) as applied in the last office action, Paper No. 6. Therefore, the rejection is maintained.

Claim Objections

4. Claims 1, 2 and 4-9 are objected to because of the following informalities: Claim 1 recites, "wherein said programming means includes means for specifying a per-pin timing in terms of sets of available waveforms for each ATE-pin of the one ATE-port". In the last paragraph on page 10 of the Applicant's Amendment B of Paper No. 7 filed 08 December 2003, the Applicant recites, "the Cheung et al. patent neither expressly describes nor suggests, specifying a per-pin timing ... for each ATE-pin of the ATE-port, as recited in claim 1".

The Examiner asserts that it is apparent from the Applicant recitation in Amendment B that the Applicant is asserting that claim 1 has the limitation whereby "a per-pin timing ... for each ATE-pin of the ATE-port" is specified whereas claim 1 only requires a means for "specifying a per-pin timing ... for each ATE-pin of the ATE-port" and does not require that "a per-pin timing ... for each ATE-pin of the ATE-port" be specified.

Appropriate correction is required.

Claims 2 and 4-9 depend from claim 1; hence inherit the deficiencies in claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2 and 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites, "wherein said programming means includes means for specifying a per-pin timing in terms of sets of available waveforms for each ATE-pin of the one ATE-port". In the last paragraph on page 10 of the Applicant's Amendment B of Paper No. 7 filed 08 December 2003, the Applicant recites, "the Cheung et al. patent neither expressly describes nor suggests, specifying a per-pin timing ... for each ATE-pin of the ATE-port, as recited in claim 1".

The Examiner asserts that it is apparent from the Applicant recitation in Amendment B that the Applicant is asserting that claim 1 has the limitation whereby "a per-pin timing ... for each ATE-pin of the ATE-port" is specified whereas claim 1 only requires a means for "specifying a per-pin timing ... for each ATE-pin of the ATE-port" and does not require that "a per-pin timing ... for each ATE-pin of the ATE-port" be specified, hence it is unclear what the intended meaning of the limitations in claim 1 are which renders the claim meaning ambiguous and indefinite.

Claims 2 and 4-9 depend from claim 1; hence inherit the deficiencies in claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheung, David K. et al. (US 5461310 A, hereafter referred to as Cheung).

See Paper No. 6 for detailed action of prior rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 5, 6, 10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung, David K. et al. (US 5461310 A, hereafter referred to as Cheung).

See Paper No. 6 for detailed action of prior rejections.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

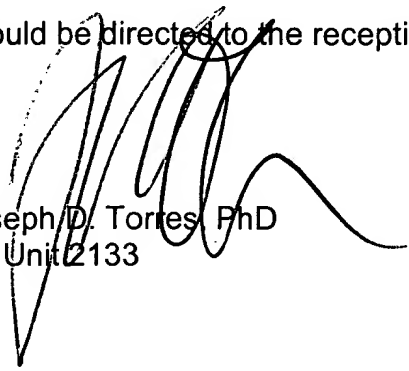
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (703) 308-7066. The examiner can normally be reached on M-F 8-5.

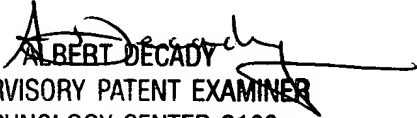
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (703) 305-9595. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-746-7240.

Joseph D. Torres, PhD
Art Unit 2133




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